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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,493	11/14/2003	Michael D. Hitchcock	C071	1013
25784	7590	03/20/2006	EXAMINER	
MICHAEL O. SCHEINBERG P.O. BOX 164140 AUSTIN, TX 78716-4140			BLACKWELL, JAMES H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/714,493	Applicant(s) HITCHCOCK ET AL.	
	Examiner James H. Blackwell	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/14/03, 6/11/04, 2/11/05, 10/17/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to an original application filed 01/20/2005 with a priority date of **06/04/1998**.
2. Claims 56-67 are pending. Applicant canceled claims 1-55 during a pre-amendment.
3. Claims 56, and 67 are independent claims.
4. It is noted that the application number located on pages 2-5 of the claims is for related application 10/673,674.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 60 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, in Claims 60 and 63 the term "posted" is unclear as to whether it relates to validation upon input of information (client-side, before submitted to server), or validation after the form has been submitted to the server (server-side).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 56-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (hereinafter Hartman, U.S. Patent No. 5,758,324 filed 02/08/1996, issued 05/28/1996) in view of Tobin (U.S. Patent No. 6,141,666 filed 01/21/1997, issued 10/30/2000), and in further view of Daniels et al. (hereinafter Daniels, U.S. Patent No. 5,758,126 filed 03/19/1996, issued 05/26/1998).

In regard to independent Claim 56 (and similarly independent Claim 67),

Hartman teaches a resume storage and retrieval system whereby potential applicants can post resumes and potential employers can search and receive resumes from those applicants.

A job applicant requests to enter new applicant data (Fig. 8B, S3), the server assigns a user ID and requests a password from the applicant (Fig. 9, S12), a resume outline form is sent (S15). The applicant fills out the outline form describing the content of their resume. This information is then stored on the server in a database (Fig. 9, S19), the applicant is then sent a list of methods for receiving an image of their resume (S20), which is then uploaded to the server where it is also saved in a database (Fig. 9, S24).

Thus, Hartman teaches *a method of processing network forms, which can be submitted by multiple job seekers to a server, which, in turn, can be accessed by multiple employers* (see Fig. 1). Though not explicitly stated by Hartman, it would have been obvious to one of ordinary skill in the art at the time of invention to have assumed that the server described by Hartman was owned and maintained by a *third party* or “clearing house” that provided standardized access to resumes for both potential employees and employers to locate one another.

Hartman fails to teach *in response to activation by a form user of a hyperlink to a form, where the hyperlinking to the form occurs directly from an individual school's web site without any visible intervening linkage to any page affiliated with another school, presenting to the form user by a third party form servicer the form directed to that individual school and customized in appearance and content in accordance with the preference of the school and including an indication of source corresponding to the school so as to provide to the form user the appearance that the form is associated with the specific school to which it is directed, the form including fields for the form users to enter user information*. However, Tobin teaches presenting HTML documents (to include forms) which contain hypertext links, presented as single links or image maps, i.e., grouped links, which are anchored to data that is dynamically retrieved by the database means in response to the particular class to which the client belongs to, i.e., based on the identity of the network site referring the client to the system's server (Col. 3, lines 23-29).

In other words, Tobin teaches that a user accesses an initial web site (e.g., a specific school), and selects a link (e.g. an admissions form). The link is to another server that based on the origin of the link (e.g. its URL), provides differing information and/or "look and feel" based on where the link came from. The content (page, forms, image maps) that is returned are "branded" according to a class.

Tobin goes on to teach that such a dynamic retrieval of data facilitates dynamic configuration of content on all anchored HTML documents so as to meet specific requirements of a marketing participant. Customization can be either a co-branded format, whereby content includes both the host's brand name and the participant's brand name, or a private label format, whereby only the marketing participant's brand name is displayed on the HTML documents presented to clients (Col. 3, lines 30-37). It is the "private label format" of branding that relates to the claimed limitation, *in response to activation by a form user of a hyperlink to a form, where the hyperlinking to the form occurs directly from an individual school's web site without any visible intervening linkage to any page affiliated with another school, presenting to the form user by a third party form servicer the form directed to that individual school and customized in appearance and content in accordance with the preference of the school and including an indication of source corresponding to the school so as to provide to the form user the appearance that the form is associated with the specific school to which it is directed, the form including fields for the form users to enter user information* (also refer to Figs. 21C, 22-28, 29A-B, 30 which depict a private label branded set of pages).

Tobin also teaches *receiving by the third party forms servicer over the computer network user information and electronic payment information entered by the user* (Fig. 30 depicts an order form that collects user information and also payment information).

Likewise, Tobin also implies a subsequent *processing by the third party forms servicer an electronic payment associated with the form, the processed payment being from the user to the one of the multiple schools to which the form is directed* (Fig. 30 contains a place the order button which would strongly suggest the claimed limitations' actions). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman and Tobin as both inventions relate to forms processing. Adding the teaching of Tobin proves the benefits of disguising 3rd party operations from users of a given web site, and for processing user information together with payment information.

In regard to dependent Claim 57, Hartman teaches *storing by the third party forms servicer at least some of the received user information entered on the form in a user database* (Col. 6, lines 48-50; resume entry information and an image of the resume are stored).

In regard to dependent Claim 58, both Hartman and Tobin fail to teach *presenting ... a second form directed to one of the multiple institutions of higher education; and automatically inserting from the user database into the second form user information previously entered onto a form directed to one of the multiple institutions by the form user*. However, Daniels teaches the notion of *turn-around*, which allows a user client (30) to generate a turn-around document in response to a document received

from sponsor client 20 (e.g., *requesting a second document*). Turn-around functionality is accessed from a "doc turn" button on the tool bar of the main menu. When the doc turn button is actuated, a dialog is opened which allows an operator of user client 30 to select which document is being responded to by document number and which turn-around document is being generated. When the turn-around document has been selected, the information fields of the GUI representing the turn-around document are *populated with information from the original electronic form* (Col. 13, lines 9-51). Thus, Daniels pre-populates information from the first form into the second requested form. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of recall of previous inputs to forms.

In regard to dependent Claims 59-62, both Hartman and Tobin fail to teach *verifying that the user information satisfies criteria specified by the one of the multiple institutions of higher education to which the form is directed*. However, Daniels teaches that an electronic forms application preferably includes instant editing functionality which verifies information entered in the fields of a form(s) against an acceptable format or a database of acceptable entries and thus provides the user of the electronic forms application with immediate feedback about the acceptability of an entry into one of the fields of the form (Col. 9, lines 21-50). Thus, Daniels teaches validation/verification of form content from a client-side application, providing instant checking before information is sent via modem elsewhere. It would have been obvious to one of ordinary skill in the

Art Unit: 2176

art at the time of invention to combine the teachings of Hartman, Tobin and Daniels as all three inventions relate to forms processing. Adding the teaching of Daniels provides the benefit of forms validation.

In regard to dependent Claim 63, both Hartman and Tobin fail to explicitly teach *verifying in accordance with first validation criteria user information on each page of the form, as it is posted, and verifying in accordance with second validation criteria user information when a completed form is submitted*. However, server-side forms validation and checking was well known at the time of invention providing the benefit of avoiding propagation of data errors.

Daniels further teaches that an electronic forms application preferably includes instant editing functionality (client-side) which verifies information entered in the fields of a form(s) against an acceptable format or a database of acceptable entries and thus provides the user of the electronic forms application with immediate feedback about the acceptability of an entry into one of the fields of the form (Col. 3, lines 5-10). Thus, Daniels teaches validation/verification of form content from a client-side application, providing instant checking before information is sent via modem elsewhere. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Hartman and Daniels as both inventions relate to forms processing. Adding the teaching of Daniels provides the added benefit of correcting errors in form field inputs before those forms are submitted, avoiding tying up server resources for at least typographical/format errors.

Art Unit: 2176

In regard to dependent Claim 64, Claim 64 contains subject matter that is similar to that found in Claim 63, and is rejected using similar arguments.

In regard to dependent Claims 65-66, Hartman teaches *A computer readable media comprising computer instructions for performing the steps of claim 56* (see Fig. 2).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is 571-272-4089. The examiner can normally be reached on Mon-Fri.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell
03/13/2006

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
3/15/2006